



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,904	02/13/2004	Jun Hirai	248884US6	6087
22850	7590	08/21/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
DEGA, MURALI K				
ART UNIT		PAPER NUMBER		
3621				
NOTIFICATION DATE		DELIVERY MODE		
08/21/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com

oblonpat@oblon.com

jgardner@oblon.com

Office Action Summary

Application No.

10/777,904

Applicant(s)

HIRAI ET AL.

Examiner

Murali K. Dega

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2009.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
4a) Of the above claim(s) None is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-12 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/CDC)
4) ☐ Interview Summary (PTO-413)
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____
Paper No(s)/Mail Date _____

DETAILED ACTION

Acknowledgements

1. This Office action is in response to the reply filed on 31 March 2009.
2. Claims 1-12 are pending and have been examined.

Objections to Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o). The specification is replete with errors. Following are some of the examples but the list of examples is not an exhaustive list. Correction or appropriate clarification of the following, as well as any other errors, is required.
 - a. The limitation of "dispersion of the printing surface" and "one or more dispersion of the printing surface" in claim 3.
 - b. The limitation of "convoluting" as recited in claims 6 and 7.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1 and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. See MPEP §2173.05(p) II. and the 112 2nd paragraph rejection below.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. With respect to claims 1 and 9:

9. The claims are indefinite because the claims are considered hybrid claims. See MPEP §2173.05(p) II. In particular, the claim is directed to neither a "process" nor a "machine" but rather embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101.

10. For example the claims recite "system" in line 1 of claim 1, "device" in line 2 of claim 1 and line 1 of claim 9 and "apparatus" in line 3 of claim 1, comprising contents copying apparatus, copying management device. In light of this evidence, one of ordinary skill in the art could reasonably interpret these recitations as express intent by Applicants to claim a machine claim.

11. Alternatively, claim 1 recites "judging agreement or disagreement of said combinations of medium identifying information", line 1 of page 3 of claims, "generating copying authorizing information for authorizing" in line 2 of page 3

and line 9 of page 6 of claims as well as other process language. One of ordinary skill in the art could also reasonably interpret these recitations as express intent by Applicants to claim a process claim. In light of this conflicting evidence, a person of ordinary skill in the art could reasonably interpret claims 1, 9 and 11 to be drawn to either a product or process.

12. Therefore in accordance with §2173.05(p) II which states that a single claim must be drawn to either a product or process (but not both) and because a potential competitor of Applicants would not know whether *possession alone* of the claimed structure constituted infringement, or alternatively, if infringement required the *execution of the recited method steps*, the claims are indefinite. If Applicants overcome this particular 35 U.S.C. §112, 2nd paragraph rejection, the related 35 U.S.C. §101 rejection will also be withdrawn.

13. Claim 1 is indefinite because the claim recites "copying-related combination information", "at the time of copying said content", "at the time of accessing said copying management device" and "at the time of access". One of ordinary skill in the art would be unable to determine the metes and bounds of the claimed invention because it is unclear if the copying is started after transfer of the combination information or after the copying apparatus accesses the management device but prior to transfer of the combination information.

14. Claim 3 recites "dispersion of printing surface" and "one or more of dispersion of the printing surface". It is unclear to one of ordinary skill in the art as to what "is dispersion of printing surface" and what the Applicants meant by "one or more of dispersion of printing surface".

15. Claim element "means for acquiring medium identifying information specific to and characterizing a recorded-contents-carrying original recording medium" as recited in claim 1 (Means Phrase #1 or MP #1).

16. Claim element "means for registering and storing said copying-related combination information received from said contents copying apparatus in advance" as recited in claim 9 (Means Phrase #10 or MP #10)

17. Claim element "means for acquiring medium identifying information specific to and characterizing a recorded-contents-carrying original recording medium" as recited in claim 11 (Means Phrase #13 or MP #13)

18. The above claim elements are means plus function limitations that invoke 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function.

19. Applicants are required to:

20. Amend the claims so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

21. Amend the written description of the specification such that it clearly links or associates the corresponding structure to the claimed function without introducing any new matter (35 U.S.C. 132(a)).

22. The above mentioned 'means for' phrases are exemplary. Applicants are respectfully requested to clearly link and associate the claimed function to the structure for *all* phrases that invoke 35 U.S.C. 112 6th paragraph.

23. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied *as much as practically possible*.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiratsuka (US 2004/0064380) in view of Akiyama et al. (US 5,805,699).
2. With respect to claim 1, 9, 10, 11 and 12:
3. Hiratsuka discloses a contents copying management system ("*contents supplying system*", Abstract, Fig. 1A, ¶¶ [0007] and [0016]), configured by connecting a contents copying apparatus ("*personal Computer*", User 'a', Fig. 1A) and a copying management device ("*Server*", Fig. 1 A, item 'SV') by way of a network ("*Communication Network*", Fig. 1A, item 'CN'), said contents copying apparatus comprising:

- a. medium ("*recording medium*", ¶ [0065]) identifying information acquiring means for acquiring medium identifying information ("*ID number of ... recording medium*", ¶ [0065]) specific to and characterizing a recorded-contents-carrying original recording medium ("*recording medium*", ¶ [0065]).
- b. apparatus identifying information ("*apparatus identification number*", ¶ [0066]) acquiring means for acquiring ("*Communication network*", Fig. 1A item 'CN') apparatus identifying information specific to and indicating said contents copying apparatus ("*personal Computer*", User 'a', Fig. 1A) itself;
- c. copying-related combination information transmitting means for transmitting ("*Communication network*", Fig. 1A item 'CN') said medium identifying information ("*ID number of ... recording medium*", ¶ [0065]) and said apparatus identifying information ("*apparatus identification number*", ¶ [0066]) to said copying management device as copying-related combination information ("*user sends an apparatus number (PC number) of each computer, which number is represented, for example, by a MAC address (media access control address), to server SV through the communication network CN together with the user ID and others*", ¶ [0018]) at the time of copying said contents;
- d. receiving means ("*Communication interface*", Fig. 1B, item 8) for receiving copying authorizing information ("*copy control data*", Abstract and Fig. 4C item S8) generated by said copying management device on

the basis ("control data", Fig. 4C item S8, "music data in accordance with the control data", Fig. 4C item P10-2 and "receive music data", Fig. 4C item K2-1) of said copying-related combination information at the time of accessing said copying management device.

e. control ("copy control", *Abstract*) means for controlling the operation of copying (*"In accordance with the contents of the copy control data Dc, information processing terminal PC determines whether or not to copy the relevant contents into external apparatus", ¶ [0007]*) said contents in response to said copying authorizing information;

f. copying management device ("server apparatus (server) SV", Fig. 1, *Abstract and ¶ [0007]*) comprising: memory means for registering and storing ("server apparatus (server) SV stores, together with numerous contents (music data) Dm, user ID information and contents (music data) purchase information Db ... for each user US (a; b) of the information processing terminal (personal computer) PC (a1, a2; b1) registered in advance", ¶ [0007]) said copying-related combination information received from said contents copying apparatus in advance.

g. Hiratsuka discloses content copying system comprising medium identifying information ("ID number of ... recording medium", ¶ [0065]), apparatus identifying information ("apparatus identification number", ¶ [0066]) and a copying management device ("server apparatus (server) SV", Fig. 1, *Abstract and ¶ [0007]*) utilizing apparatus identification or recording medium identification but does not disclose using the

combination of two identifications in generating the copy control authorization.

h. However, Akiyama teaches use of two identifiers (*"software identifier and storage medium identifier", Abstract*) that are sent to a server (*"sent to a central site which manages licenses for the right to copy", Abstract*) and generation of copying authorization information (*"signature", Abstract*) based on the two identifiers (*"produces a first signature from those identifiers", Abstract*) which is sent back to the copying apparatus (*"sends it back to the user's site", Abstract*).

i. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the system of Hiratsuka to include generation of copying authorization information (signature) by combining the two identifiers, as per the teachings of Akiyama in developing a method for copying, for the purposes of preventing unauthorized copying of the medium contents, with neither undue experimentation nor unexpected results.

j. Hiratsuka discloses copying authorizing information (*"copy control data", Abstract and Fig. 4C item S8*) generating means for comparing said copying-related combination information received at the time of access by said contents copying apparatus with said copying-related combination information registered in said memory means in advance (*"contents ID information (music reference numbers) and copy control data Dc of already supplied contents as user information Du for each user*

US (a; b) of the information processing terminal (personal computer) PC (a1, a2; b1) registered in advance"< ¶ [0007]), but does not explicitly disclose judging agreement or disagreement of said combinations of medium identifying information and apparatus identifying information, generating copying authorizing information for authorizing an operation of copying the contents in response to agreement of said combinations but generating copying non-authorizing information for not authorizing any operation of copying the contents in response to disagreement of said combinations.

k. However, Akiyama teaches the authorization information ("*signature*") being compared ("The signature generating/**comparing** means 8 compares this signature with the first-mentioned signature stored in the target storage medium 3", C 4, ll. 32-34) prior to the copying and judging agreement or disagreement of said combinations of medium identifying information and apparatus identifying information, generating copying authorizing information ("*signature*") for authorizing an operation of copying the contents ("If the comparison result indicates coincidence of the two codes CS and CS', a switch 19 will enable the software program having the software identifier SIDI to be written into the target MO disc 12", C 6, ll. 32-36) in response to agreement, but generating copying non-authorizing information for not authorizing any operation of copying the contents in response to disagreement of said combinations ("According to the result of the comparison between CS and CS', the process proceeds

in different ways. If the two certificate codes are found identical, the process goes to the next step S7. Otherwise, the process is terminated without copying the software program from the CD-ROM to the MO disc", C 5, ll. 6-11).

I. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the system of Hiratsuka to include the step of comparing the authorization information (signatures) from both instances to ensure matching, as per the teachings of Akiyama in developing a method for copying, for the purposes of preventing unauthorized copying of the medium contents, with neither undue experimentation nor unexpected results.

m. copying authorizing information transmitting ("*Communication network*", Fig. 1A item 'CN') means for transmitting said copying authorizing information to said contents copying apparatus ("*personal Computer*", User 'a', Fig. 1A).

4. With respect to claim 2:

5. Hiratsuka discloses wherein said control means ("control data", Abstract) controls reproduction of said copied contents according to said copying authorizing information ("In accordance with the contents of the copy control data, information processing terminal PC determines whether or not to copy", Abstract, "whether or not to execute the copying in accordance with the contents of the copy control data", ¶ [0041]).

6. With respect to claim 3:

7. Hiratsuka discloses wherein said medium identifying information is dispersion of the printing surface of said recorded-contents-carrying original recording medium ("*a portable-type recording medium RM*", ¶ [0025]) produced ("*recorded into the recording medium RM*", ¶ [0054]) at the time of printing, dispersion information of the signals on the recording surface of said recorded-contents-carrying original recording medium, the signals recorded on the recording surface or a combination of one or more of dispersion of the printing surface of said recorded-contents-carrying original recording medium produced at the time of printing, dispersion information of the signals on the recording surface of said recorded-contents-carrying original recording medium, or the signals recorded on the recording surface.

8. With respect to claim 4:

9. Hiratsuka discloses wherein said control means controls copying of said contents according to said copying authorizing information ("*copy control data*", *Abstract*) and displays a predetermined warning image on display means ("*personal computer*", *Fig. 1A*) when copying is not authorized according to said copying authorizing information ("*the terminal PC display a message that "the music data cannot be sent because the music data are already copied"*", ¶ [0057]).

10. With respect to claim 5:

11. Hiratsuka discloses wherein said memory means registers said medium identifying information ("*ID number of ... recording medium*", ¶ [0065]) according to the title ("*the list of items (music titles, numbers, etc.)*", ¶ [0055]) of said

contents on a title by title basis when registering and storing in advance (*"server apparatus (server) SV stores, together with numerous contents (music data) Dm, user ID information and contents (music data) purchase information Db ... for each user US (a; b) of the information processing terminal (personal computer) PC (a1, a2; b1) registered in advance", ¶ [0007]*) said copying-related

combination information received from said contents copying apparatus

n. copying authorizing information (*"copy control data"*) generating means selects said medium identifying information to be compared according to said title (*"music titles"*) when it compares said copying-related combination information received at the time of said access of said contents copying apparatus with said copying-related combination information registered in advance in said memory means (*"the user wishes to send to the relevant electronic musical instrument KD by a user operation 5 from the list of items (music titles, numbers, etc.) of the already purchased music data Dmd stored in storing device 4 (HD) and displayed on the display 6, the music reference number of the indicated item is sent to the server SV, thereby executing a request for copying of the corresponding music data (P9)", ¶ [0055]*).

12. With respect to claims 6 and 7:

13. Hiratsuka discloses wherein said control (*"copy control data", Abstract*) means generates the contents to be copied, convoluting said medium identifying information (*"ID number of ... recording medium", ¶ [0065]*) and said apparatus

identifying information ("*apparatus identification number*", ¶ [0066]) into said contents, when copying said contents and controls reproduction of said copied contents by taking out the medium identifying information and the apparatus identifying information from said copied contents, transmitting the combined information to said copying management device by means of said copying-related combination information transmitting means ("Communication network", Fig. 1A) and receiving said copying authorizing information generated by said copying management device ("server", Fig. 1A) on the basis of the combination of the medium identifying information and apparatus identifying information by the receiving means when reproducing said copied contents. (Also see explanations 'g', 'h' and 'i').

14. With respect to claim 8:

15. Hiratsuka discloses wherein said control means encodes ("downloaded music data are coded", ¶ [0064]) the contents, using said apparatus identifying information as key ("using the user ID as a key", ¶ [0064]), when carrying out an operation of copying said contents.

Invocation of 35 U.S.C. § 112 6th Paragraph

Invocation:

Means Phrase #1

16. The Examiner concludes that in accordance with MPEP § 2181 I., the phrase “means for acquiring medium identifying information specific to and characterizing a recorded-contents-carrying original recording” as recited in claim 1 (“Means Phrase #1” or “MP#1”) invokes 35 U.S.C. § 112 6th paragraph. To support his position, the Examiner notes the following:

17. The Examiner finds that MP#1 expressly recites “means for.” In accordance with MPEP § 2181 I., the Examiner concludes that MP#1 meets Invocation Prong (A) because “means for” is recited.

18. In accordance with MPEP § 2181 I., the Examiner concludes that MP#1 meets Invocation Prong (B) because the phrase recites the function of “acquiring medium identifying information specific to and characterizing a recorded-contents-carrying original recording”. Because nothing in the written description suggests that Applicant has intended the unambiguous language to be construed in a manner inconsistent with its ordinary meaning, the claimed function will have its ordinary meaning.

19. In accordance with MPEP §2181, the Examiner concludes that MP#1 meets Invocation Prong (C) because a review of the claim itself clearly shows that the claim does not recite sufficient structure for performing the claimed function.

Means Phrase #2

20. It is the Examiner's position that the "means for acquiring apparatus identifying information specific to and indicating said contents copying apparatus itself" in claim 1 ("Means Phrase #2" or "MP#2") invokes 35 U.S.C. 112 6th paragraph.

a. MP#2 meets Invocation Prong (A) because "means for" is recited.

b. MP#2 meets Invocation Prong (B) because the phrase recites the function of "acquiring apparatus identifying information specific to and indicating said contents copying apparatus itself". This function will have its ordinary and plain meaning.

c. MP#2 meets Invocation Prong (C) because the claim does not recite sufficient definite structure for performing the function of "acquiring".

d. Based upon the Examiner's review of the original disclosure, the claimed language, and Applicants' March 2009 Remarks, the Examiner finds the corresponding structure to be a general device computer as discussed above.

Means Phrase #3

21. It is the Examiner's position that the "means for transmitting said medium identifying information and said apparatus identifying information..." in claim 1 ("Means Phrase #3" or "MP#3") invokes 35 U.S.C. 112 6th paragraph.

a. MP#3 meets Invocation Prong (A) because "means for" is recited.

b. MP#3 meets Invocation Prong (B) because the phrase recites the function of “transmitting said medium identifying information and said apparatus identifying information...” This function will have its ordinary and plain meaning.

c. MP#3 meets Invocation Prong (C) because the claim does not recite sufficient definite structure for performing the function of “transmitting”.

d. Based upon the Examiner's review of the original disclosure, the claimed language, and Applicants' March 2009 Remarks, the Examiner finds the corresponding structure to be a general device computer as discussed above.

Means Phrase #4

22. It is the Examiner's position that the “means for receiving copying authorizing information generated by said copying management device ...” in claim 1 (“Means Phrase #4” or “MP#4”) invokes 35 U.S.C. 112 6th paragraph.

a. MP#4 meets Invocation Prong (A) because “means for” is recited.

b. MP#4 meets Invocation Prong (B) because the phrase recites the function of “receiving copying authorizing information generated by said copying management device ...” This function will have its ordinary and plain meaning.

c. MP#4 meets Invocation Prong (C) because the claim does not recite sufficient definite structure for performing the function of “receiving”.

d. Based upon the Examiner's review of the original disclosure, the claimed language, and Applicants' March 2009 Remarks, the Examiner finds the corresponding structure to be a general device computer as discussed above.

Means Phrase #5

23. It is the Examiner's position that the "means for controlling the operation of copying said contents in response to said copying authorizing information" in claim 1 ("Means Phrase #5" or "MP#5") invokes 35 U.S.C. 112 6th paragraph.

a. MP#5 meets Invocation Prong (A) because "means for" is recited.

b. MP#5 meets Invocation Prong (B) because the phrase recites the function of "controlling the operation of copying said contents in response to said copying authorizing information" This function will have its ordinary and plain meaning.

c. MP#5 meets Invocation Prong (C) because the claim does not recite sufficient definite structure for performing the function of "controlling".

d. Based upon the Examiner's review of the original disclosure, the claimed language, and Applicants' March 2009 Remarks, the Examiner finds the corresponding structure to be a general device computer as discussed above.

Means Phrase #6

24. It is the Examiner's position that the "means for registering and storing" in claim 1 ("Means Phrase #6" or "MP#6") invokes 35 U.S.C. 112 6th paragraph.

a. MP#6 meets Invocation Prong (A) because "means for" is recited.

b. MP#6 meets Invocation Prong (B) because the phrase recites the function of "registering and storing." This function will have its ordinary and plain meaning.

c. MP#6 meets Invocation Prong (C) because the claim does not recite sufficient definite structure for performing the function of “registering and storing”.

d. Based upon the Examiner’s review of the original disclosure, the claimed language, and Applicants’ March 2009 Remarks, the Examiner finds the corresponding structure to be a general device computer as discussed above.

Means Phrase #7

25. It is the Examiner’s position that the “means for comparing said copying-related combination information” in claim 1 (“Means Phrase #7” or “MP#7”) invokes 35 U.S.C. 112 6th paragraph.

a. MP#7 meets Invocation Prong (A) because “means for” is recited.

b. MP#7 meets Invocation Prong (B) because the phrase recites the function of “comparing said copying-related combination information” This function will have its ordinary and plain meaning.

c. MP#7 meets Invocation Prong (C) because the claim does not recite sufficient definite structure for performing the function of “comparing”.

d. Based upon the Examiner’s review of the original disclosure, the claimed language, and Applicants’ March 2009 Remarks, the Examiner finds the corresponding structure to be a general device computer as discussed above.

Means Phrase #8

26. It is the Examiner's position that the "means for transmitting said copying authorizing information to said contents copying apparatus" in claim 1 ("Means Phrase #8" or "MP#8") invokes 35 U.S.C. 112 6th paragraph.

a. MP#8 meets Invocation Prong (A) because "means for" is recited.

b. MP#8 meets Invocation Prong (B) because the phrase recites the function of "transmitting said copying authorizing information to said contents copying apparatus" This function will have its ordinary and plain meaning.

c. MP#8 meets Invocation Prong (C) because the claim does not recite sufficient definite structure for performing the function of "transmitting".

d. Based upon the Examiner's review of the original disclosure, the claimed language, and Applicants' March 2009 Remarks, the Examiner finds the corresponding structure to be a general device computer as discussed above.

Means Phrase #9

27. It is the Examiner's position that the "means for receiving medium identifying information specific to and characterizing" in claim 9 ("Means Phrase #9" or "MP#9") invokes 35 U.S.C. 112 6th paragraph.

a. MP#9 meets Invocation Prong (A) because "means for" is recited.

b. MP#9 meets Invocation Prong (B) because the phrase recites the function of "receiving medium identifying information specific to and characterizing" This function will have its ordinary and plain meaning.

c. MP#9 meets Invocation Prong (C) because the claim does not recite sufficient definite structure for performing the function of "receiving".

d. Based upon the Examiner's review of the original disclosure, the claimed language, and Applicants' March 2009 Remarks, the Examiner finds the corresponding structure to be a general device computer as discussed above.

Means Phrase #10

28. It is the Examiner's position that the "memory means for registering and storing" in claim 9 ("Means Phrase #10" or "MP#10") invokes 35 U.S.C. 112 6th paragraph.

a. MP#10 meets Invocation Prong (A) because "means for" is recited.

b. MP#10 meets Invocation Prong (B) because the phrase recites the function of "registering and storing." This function will have its ordinary and plain meaning.

c. MP#10 meets Invocation Prong (C) because the claim does not recite sufficient definite structure for performing the function of "registering and storing".

d. Based upon the Examiner's review of the original disclosure, the claimed language, and Applicants' March 2009 Remarks, the Examiner finds the corresponding structure to be a general device computer as discussed above.

Means Phrase #11

29. It is the Examiner's position that the "means for comparing said copying-related combination information received" in claim 9 ("Means Phrase #11" or "MP#11") invokes 35 U.S.C. 112 6th paragraph.

a. MP#11 meets Invocation Prong (A) because "means for" is recited.

b. MP#11 meets Invocation Prong (B) because the phrase recites the function of "comparing said copying-related combination information received". This function will have its ordinary and plain meaning.

c. MP#11 meets Invocation Prong (C) because the claim does not recite sufficient definite structure for performing the function of "comparing".

d. Based upon the Examiner's review of the original disclosure, the claimed language, and Applicants' March 2009 Remarks, the Examiner finds the corresponding structure to be a general device computer as discussed above.

Means Phrase #12

30. It is the Examiner's position that the "means for transmitting said copying authorizing information" in claim 9 ("Means Phrase #12" or "MP#12") invokes 35 U.S.C. 112 6th paragraph.

a. MP#12 meets Invocation Prong (A) because "means for" is recited.

b. MP#12 meets Invocation Prong (B) because the phrase recites the function of "transmitting said copying authorizing information". This function will have its ordinary and plain meaning.

c. MP#12 meets Invocation Prong (C) because the claim does not recite sufficient definite structure for performing the function of "transmitting".

d. Based upon the Examiner's review of the original disclosure, the claimed language, and Applicants' March 2009 Remarks, the Examiner finds the corresponding structure to be a general device computer as discussed above.

Means Phrase #13

31. It is the Examiner's position that the "means for acquiring medium identifying information specific to and characterizing a..." in claim 11 ("Means Phrase #13" or "MP#13") invokes 35 U.S.C. 112 6th paragraph.

- a. MP#13 meets Invocation Prong (A) because "means for" is recited.
- b. MP#13 meets Invocation Prong (B) because the phrase recites the function of "acquiring medium identifying information specific to and characterizing a...". This function will have its ordinary and plain meaning.
- c. MP#13 meets Invocation Prong (C) because the claim does not recite sufficient definite structure for performing the function of "acquiring".
- d. Based upon the Examiner's review of the original disclosure, the claimed language, and Applicants' March 2009 Remarks, the Examiner finds the corresponding structure to be a general device computer as discussed above.

Means Phrase #14

32. It is the Examiner's position that the "means for acquiring apparatus identifying information specific to and indicating" in claim 11 ("Means Phrase #14" or "MP#14") invokes 35 U.S.C. 112 6th paragraph.

- a. MP#14 meets Invocation Prong (A) because "means for" is recited.
- b. MP#14 meets Invocation Prong (B) because the phrase recites the function of "acquiring apparatus identifying information specific to and indicating". This function will have its ordinary and plain meaning.

c. MP#14 meets Invocation Prong (C) because the claim does not recite sufficient definite structure for performing the function of "acquiring".

d. Based upon the Examiner's review of the original disclosure, the claimed language, and Applicants' March 2009 Remarks, the Examiner finds the corresponding structure to be a general device computer as discussed above.

Means Phrase #15

33. It is the Examiner's position that the "means for transmitting said medium identifying information" in claim 11 ("Means Phrase #15" or "MP#15") invokes 35 U.S.C. 112 6th paragraph.

a. MP#15 meets Invocation Prong (A) because "means for" is recited.

b. MP#15 meets Invocation Prong (B) because the phrase recites the function of "transmitting said medium identifying information". This function will have its ordinary and plain meaning.

c. MP#15 meets Invocation Prong (C) because the claim does not recite sufficient definite structure for performing the function of "transmitting".

d. Based upon the Examiner's review of the original disclosure, the claimed language, and Applicants' March 2009 Remarks, the Examiner finds the corresponding structure to be a general device computer as discussed above.

Means Phrase #16

34. It is the Examiner's position that the "means for receiving copying authorizing information" in claim 11 ("Means Phrase #16" or "MP#16") invokes 35 U.S.C. 112 6th paragraph.

- a. MP#16 meets Invocation Prong (A) because "means for" is recited.
- b. MP#16 meets Invocation Prong (B) because the phrase recites the function of "receiving copying authorizing information". This function will have its ordinary and plain meaning.
- c. MP#16 meets Invocation Prong (C) because the claim does not recite sufficient definite structure for performing the function of "receiving".
- d. Based upon the Examiner's review of the original disclosure, the claimed language, and Applicants' March 2009 Remarks, the Examiner finds the corresponding structure to be a general device computer as discussed above.

Means Phrase #17

35. It is the Examiner's position that the "means for controlling the operation of copying" in claim 11 ("Means Phrase #17" or "MP#17") invokes 35 U.S.C. 112 6th paragraph.

- a. MP#17 meets Invocation Prong (A) because "means for" is recited.
- b. MP#17 meets Invocation Prong (B) because the phrase recites the function of "controlling the operation of copying". This function will have its ordinary and plain meaning.

c. MP#17 meets Invocation Prong (C) because the claim does not recite sufficient definite structure for performing the function of "controlling".

d. Based upon the Examiner's review of the original disclosure, the claimed language, and Applicants' March 2009 Remarks, the Examiner finds the corresponding structure to be a general device computer as discussed above.

Claim Construction.

36. Because claim 12 does not recite "step for," claim 12 fails Prong (A) as set forth in MPEP §2181. Because claim 12 fails Prong (A) as set forth in MPEP §2181, the Examiner concludes that claim 12 does not invoke 35 U.S.C. §112, 6th Paragraph. See also *Ex parte Miyazaki*, 89 USPQ2d 1207, 1215-16 (B.P.A.I. 2008)(precedential).

37. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims. Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

- a. **Access:** 1. The act of reading data from or writing data to memory.
- 2. Connection to the Internet or other network or system. Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.

- b. **Configure:** "to set up for operation esp. in a particular way." Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield, M.A. 1986.
- c. **Device:** "A generic term for a computer subsystem." Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.
- d. **For:** "1 a -- used as a function word to indicate purpose... b -- used as a function word to indicate an intended goal" Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.
- e. **If:** "1 a : in the event that" Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield, M.A., 1986.
- f. **Information:** "2 a . . . (3): FACTS, DATA . . ." Merriam-Webster's Collegiate Dictionary, 10th Edition, Merriam-Webster Inc., Springfield, M.A., 1997.
- g. **Memory:** "A device where information can be stored and retrieved. In the most general sense, memory can refer to external storage such as disk drives or tape drives; in common usage it refers only to the fast semiconductor storage (RAM) directly connected to the processor." Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.

Response to Arguments

Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Murali K. Dega whose telephone number is (571)270-5394. The examiner can normally be reached on Monday to Thursday 7.30 to 4.00 ET.
3. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571)272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
4. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M.K.D./

Application/Control Number: 10/777,904

Art Unit: 3621

Page 29

Paper No: 20090808

Art Unit 3621

/EVENS J. AUGUSTIN/

Primary Examiner, Art Unit 3621